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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/234,559	01/20/1999	SUNDARAM RAMAKESAVAN	INTL-0170-US	5930

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EXAMINER

KOSTAK, VICTOR R

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 02/17/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/234,559

Applicant(s)

RAMAKESAVAN, SUNDARAM

Examiner

Victor R. Kostak

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

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1. This rejection is in response to the Board decision of 09/10/03 in which the rejection based on the Russo reference has been reversed.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14 and 16 are now rejected under 35 U.S.C. 102(b) as being anticipated by Dan et al.

Dan (noting particularly Figs. 1, 4 and 5) provides VCR-type functions to a client (recipient) in a VOD system (col. 1 lines 54-56; col. 2 lines 22-23), the hardware of the single arrangement shown in Fig. 1 described in general terms. Server 30 distributes demanded videos to subscribers at client stations 10 through communication network 20, and storage for the video can be done at either the headend or client stations in buffers 60 and 70 (col. 2 lines 27-29). The client is provided with a video from storage in response to a request for play (col. 2 lines 29-30), and a request code is generated (in a composite request record database 110; Fig. 2, the client scheduler 40 at the headend handling the record). When a pause request is prompted, the video is subsequently resumed automatically according to a resume request code sent to the headend (e.g. col. 2 lines 46-49) as indicated in the flow chart in Fig.5, thereby meeting claim 14.

As for claim 16, the system inherently includes software and/or hardware for enabling the requests and codes shown in the data stream in Fig. 2 and the flow charts in Figs. 4-8 to be processed, as well as other requisite instructions to be executed.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15 and 24 are now rejected under 35 U.S.C. 103(a) as being unpatentable over Dan et al.

Regarding claim 15, the examiner takes Official notice that some type of user interface must be included in order for the user to prompt and access the headend to selectively retrieve videos for eventual display on a screen. Therefore, it would have been obvious to use any suitable displayable user interface to provide the exchanges between the client and headend stations initiated by the client, and since GUIs are well known such devices, it would accordingly have been obvious to use a GUI to would provide ready availability.

As for claim 24, the examiner also takes Official notice that some type of tactile action must be made by the user at the interface since the user initiates the resumption of video play. Since depressible keys or buttons are very typical means for physically prompting various requests and functions, it would have been obvious to include either of the two at the user interface for enabling the preferred functions to be carried out.

It is further noted that resume codes are generated for prompting the scheduler to resume play (noting col. 2 lines 36-49 again).

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4. Claims 1-13, 17-23, 25 and 26 are now rejected under 35 U.S.C. 103(a) as being unpatentable over Dan et al. in view of Saward.

Addressing claim 1, both the headend and the client station can store movies, as pointed out above.

It would have been obvious to one of ordinary skill in the art to provide measures to ensure restricted access to the videos since Dan's system is an on-demand system (i.e. available to paying clients only). In view of this implicit assumption, it would accordingly have been obvious to one of ordinary skill in the art to use any suitable method for discouraging accessibility to non-paying customers, such as by encrypting (or scrambling) the videos, which is very well known technique and as shown by Saward, who in a system similar to that of Dan, downloads recordable videos in a subscription-based video system (noting Fig. 3 or 5). In view of the fact that decrypting (descrambling) would have been obvious to incorporate in the system of Dan as taught by Saward, the system of Dan as modified by Saward would require the decryption stage to be activated upon initiation of the play, pause, and/or the resume codes used by Dan so managed by an inherent internal controller, thereby providing unscrambled and therefore presentable videos.

As for claim 2, Dan inherently includes some type of system controller as mentioned above (and as further pointed out that he describes his system in general terms and in little detail). It would have been clearly obvious for the controller to include (at least) some basic processing ('processing' also being a very general term) since any function carried out can be defined as a process. (It is noted that the VCR-type functions are processes and are carried out by the system in general).

Considering claim 3, the system of Dan as modified by Saward would activate the descrambling stage upon requesting play of a video stored in buffer 70 since descrambling would only be necessary when the video is accessed for presentation (i.e. subsequent to storage).

As for claim 4, the VOD system shown in Fig. 1 of Dan includes plural client stations served by a common server, and the videos requested by respective clients can be transmitted at a later time in accordance with request time codes, as well as other function codes (noting, e.g. Fig. 2). Dan as modified by Saward would involve the headend transmitting decryption data (signal 28 of Saward), inherently in a controlled fashion, upon approval of authorization of the client, wherein the VCR codes of Dan would prompt the descrambling/decoding/playing process for eventual video presentation.

As for claim 5, Dan includes client ID codes (col. 2 lines 41-42) for communicating with the immediate client in question.

As for claim 6, it would have been obvious to either incorporate the controller into the transmitter as a single unit or to have the components separate but in direct communication, either arrangement being inconsequential since they carry out their respective functions.

Regarding claims 7 and 8, Dan does not give any details or specific examples of his system components, as, for example, he describes his communication network 20 in only those exact terms. Such general descriptions naturally lead the skilled artisan to consider any and all possible typical communication links, such as very well known cable and satellite media, which would have been obvious to use in any type of VOD system, as Saward mentions both types in his communication system: col. 4 line 66 – col. 5 line 2).

As for claim 9, Dan also provides movie ID codes (col. 2 lines 41-42).

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As for claim 21, the headend is capable of determining the waiting period of the play/resume requests for each client (e.g. col. 4 lines 63-65). In view of this, it would have been obvious to one of ordinary skill in the art to provide the viewer with notification information (in character or numeric form, such not being critical) from the headend acknowledging the request as well as the status, for the purpose of informing the viewer when the resumption of play would become available, which would prompt the viewer to take action dictated based on the waiting period.

Considering claims 10 and 17, Dan as modified by Saward would involve decrypting the stored video for play of that video, and pausing and subsequently automatically resuming the video using the VCR request codes when the viewer decides to suspend play.

As for claims 11, 12, 18 and 19, it would have been obvious to one of ordinary skill in the art to have the encrypted video and the decryption data (key) be from the same source or from separate sources, such being inconsequential since the client station receives both regardless.

Regarding claim 20, Dan includes a client ID, as mentioned previously.

As for claim 22, it would have been obvious to one of ordinary skill in the art to provide the viewer with information (in character or numeric form, such being inconsequential as noted above) from the headend notifying the viewer acknowledging the request as well as the status, for the purpose of informing the viewer when the video would become available for resumption of play, which would prompt the viewer to take action dictated based on the waiting period.

As for claim 23, it would have been obvious and in line with appropriate business sense not to charge extra for resuming play since the viewer normally downloads videos expecting completion of play.

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Concerning claim 25, Saward sends data (i.e. "key") to enable decryption.

As for claim 26, it would have been clearly obvious to resume play where the video last stopped to provide continuity.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor R. Kostak whose telephone number is 703 305-4374. The examiner can normally be reached on Monday - Friday from 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703 305-4795. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9306 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 308-HELP.

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Victor R. Kostak
Primary Examiner
Art Unit 2614

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